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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/954,823	09/18/2001	Edward L. Beery II	EBP001US	8192
43581	7590	07/18/2006	EXAMINER	
CAVEN & AGHEVLI LLC 9249 S. BROADWAY BLVD UNIT 200-201 HIGHLANDS RANCH, CO 80129			NGUYEN, TRI V	
			ART UNIT	PAPER NUMBER
			1751	

DATE MAILED: 07/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/954,823	BEERY, EDWARD L.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Tri V. Nguyen	1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 9-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. In the amendment file on May 04, 2006, Claims 1-8 have been cancelled and Claims 9-28 have been added. The currently pending claims considered below are Claims 9-28.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 9-23, 25, 26 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Katz et al. (US 6,055,513).

Claim 9: Katz et al. discloses a computer-based method for presenting one or more promotions, comprising:

- a. receiving, in a computing system, a signal identifying a first product associated with an order (col 15, lines 38-65 and col 22, lines 31-45);
- b. associating a first product identifier with the first product (col 24, lines 31-49);
- c. presenting, via a user interface, one or more promotions when one or more promotions for at least a second product are associated with the first product identifier (col 13, lines 27-51; col 17, line 37 to col 18, line 15; col 23, line 62 to col 25, line 55 and col 26, line 66 to col 27, line 21).

Claim 10: Katz et al. discloses the method of claim 9, wherein presenting, via a user interface, one or more promotions comprises determining, based on the first product identifier, whether

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one or more promotions for at least a second product are associated with the first product identifier (col 23, line 62 to col 25, line 55).

Claim 11: Katz et al. discloses the method of claim 10, wherein determining, based on the first product identifier, whether one or more promotions for at least a second product are associated with the first product identifier comprises comparing the first product identifier with a list of product identifiers associated with promotional offers (col 23, line 62 to col 25, line 55).

Claim 12: Katz et al. discloses the method of claim 9, wherein a promotion is associated with a combination of one or more product identifiers (col 23, line 62 to col 25, line 55).

Claim 13: Katz et al. discloses the method of claim 9, further comprising presenting one or more replacement products in the user interface (col 23, line 62 to col 25, line 55).

Claim 14: Katz et al. discloses the method of claim 9, further comprising receiving, in the computing system, a signal requesting processing for one or more promotions (col 23, line 62 to col 25, line 55).

Claim 15: Katz et al. discloses the method of claim 14, further comprising replacing the first product with the second product when a replacement promotion is selected (col 22, lines 31-45 and col 23, line 62 to col 25, line 55).

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Claim 16: Katz et al. discloses the method of claim 14, further comprising adding another product to the order when an enhancement promotion is selected (col 22, lines 31-45 and col 23, line 62 to col 25, line 55).

Claims 17-22 disclose the computer program on a readable medium of the method Claims 9-16 respectively. The prior art of Katz et al. as set forth above in Claims 9-16 is upon to reject Claims 17-22.

Claim 23: Katz et al. discloses a computer-based method of delivering a promotional offer to a consumer, comprising:

- a. storing criteria for a promotional offer in a computer-readable memory (col 15, lines 38-65 and col 22, lines 31-45);
- b. receiving, in a computing system, a signal identifying a first product associated with a consumer order (col 15, lines 38-65; col 22, lines 31-45 and col 24, lines 31-49);
- c. comparing a first product identifier associated with the first product with the criteria for a promotional offer (col 13, lines 27-51; col 17, line 37 to col 18, line 15; col 23, line 62 to col 25, line 55 and col 26, line 66 to col 27, line 21); and
- d. presenting a promotional offer in a user interface when the first product identifier corresponds to a criteria for a promotional offer (col 13, lines 27-51; col 17, line 37 to col 18, line 15; col 23, line 62 to col 25, line 55 and col 26, line 66 to col 27, line 21).

Claim 25: Katz et al. discloses the method of claim 23, further comprising:

- a. receiving, in the computing system, a signal requesting processing for one or more promotions (col 22, lines 31-45 and col 23, line 62 to col 25, line 55);

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- b. replacing the first product with the second product when a replacement promotion is selected (col 22, lines 31-45 and col 23, line 62 to col 25, line 55); and
- c. adding another product to the order when an enhancement promotion is selected (col 22, lines 31-45 and col 23, line 62 to col 25, line 55).

Claims 26 and 28 disclose the computer program on a readable medium of the method Claims 23 and 25 respectively. The prior art of Katz et al. as set forth above in Claims 23 and 25 is upon to reject Claims 26 and 28.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 24 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katz et al. (US 6,055,513).

Claim 24: Katz et al. discloses the method of claim 23, but does not explicitly disclose wherein storing criteria for a promotional offer in a computer-readable memory comprises associating the first product identifier with one or more promotional codes. Katz recites the use of promotional offers in the field of upselling and cross-marketing (col 13, lines 27-51; col 17, line 37 to col 18, line 15; col 23, line 62 to col 25, line 55 and col 26, line 66 to col 27, line 21). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method as taught by Katz et al., with the use of promotional codes since it was known in the art that promotions are identified by codes to provide a way of tracking the

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promotions.

Claim 27 discloses the computer program on a readable medium of the method Claims 24. The prior art of Katz et al. as set forth above in Claim 24 is upon to reject Claim 27.

### ***Response to Arguments***

6. Applicant's arguments with respect to claims 9-28 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

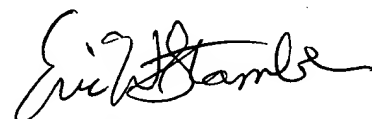
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tri V. Nguyen whose telephone number is (571) 272-6965. The examiner can normally be reached on M-F 8:00 AM to 5:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on (571) 272-1029 and Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

nvt



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